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09/636,031	08/11/2000	Joseph G. Wirtz	39992-400800	9611

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SEYFARTH SHAW, LLP
Suite 4200
55 East Monroe Street
Chicago, IL 60603-5803

EXAMINER

HAQ, NAEEM U

ART UNIT PAPER NUMBER

3625

DATE MAILED: 07/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/636,031

Applicant(s)

WIRTZ ET AL.

Examiner

Naeem Haq

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 13-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 20-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

This action is in response to the Applicants' amendment filed on May 12, 2006. Claims 1-25 are pending. Claims 13-19 were withdrawn in the previous Office Action and remain withdrawn. Claims 1-12 and 20-25 will be considered for examination.

Applicants' amendment to claims 1 and 20 is sufficient to overcome the rejection of claims 1-12 and 20-25 under 35 USC 112, second paragraph. This rejection is withdrawn.

Final Rejection

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 and 20-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bezos et al. (US 6,029,141) ("Bezos").

Referring to claim 1: Bezos teaches a method of placing an electronic order from a data processing unit operated by a user, comprising:

- receiving, at the data processing unit, a web page from a hosting web site during an interactive session between the data processing unit and a hosting server over a computer network, wherein said receiving a web

page includes displaying the web page on a display unit in communications with the data processing unit, wherein said displaying the web page includes presenting one or more advertised products (col. 6, line 59 – col. 7, line 20; col. 11, lines 28-62; Figure 5, items “100” and “108”; Figure 6, item “120”; Abstract);

- receiving, at the data processing unit, a purchase request to purchase an advertised product, said purchase request being generated by the user (col. 2, line 47 – col. 3, line 7; col. 7, lines 30-34; col. 14, lines 38-51).
- providing, an order form for the advertised product in response to the purchase request without having to exchange additional communications with the hosting server, wherein said providing an order form includes presenting the order form on the display unit to the user (Figure 10c; col. 15, lines 44-50);
- wherein the data processing unit remains connected to the hosting server to continue the interactive session while the user operates an input device in communication with the data processing unit to complete the order form (col. 12, lines 32-41: “Another alternative is for the associate Web site 100 to be created using an HTML frame format. The bottom frame can be designated as the target area frame for the merchant’s Web site 106. The top frame can provide navigational controls for the customer to return to the associate’s Web site 100 after selection of a particular product at the merchant’s Web site 106. **This allows the customer to maintain an associate’s Web page frame while viewing and processing product purchases at the merchant’s Web site 106.**”) (emphasis added).

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Bezos does not teach that the order form is provided by the data processing unit (i.e. customer computer). However, Bezos discloses that the customer's computer is capable of presenting web documents embedded in a web browser of the customer's computer (Figure 1, item 112"; Figure 5, items "C" and "G"). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to relocate the order form (Figure 1, item "136"; Figure 10c) from the merchant web site to the customer's computer since it has been held that rearranging parts of an invention involves only routine skill in the art. (*In re Japikse*, 86 USPQ 70).

Referring to claim 2: Bezos teaches all the limitations of claim 1 as noted above. In addition, Bezos teaches processing, by the data processing unit, the order form in response to instructions from the user to send the order form to a merchant server to thereby produce the electronic order without having to exchange additional communications with the hosting server, wherein said processing the order form includes exchanging communications between the merchant server and the data processing unit over the computer network (col. 14, lines 38-51; col. 15, lines 44-50).

Referring to claim 12: Bezos teaches receiving a web page over the global Internet (Figure 1, item "104"; col. 6, lines 1-11).

Referring to claim 20: Claim 20 is rejected under the same rationale as set forth above in claim 1.

Referring to claim 22: Bezos teaches computer code means to present descriptive information related to said advertised product in response to a descriptive

information request, wherein said descriptive information includes an option to send purchase request (col. 7, lines 6-20).

Referring to claim 23: Claim 23 is rejected under the same rationale as set forth above in claim 2.

Referring to claim 25: Bezos teaches that the computer network includes the global Internet (Figure 1, item "104"; col. 6, lines 1-11).

Claims 6, 7, 21, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bezos (US Patent 6,029,141) in view of Official Notice.

Referring to claim 6: Bezos teaches all the limitations of claim 2 as noted above. Bezos does not teach the step of confirming, by the processing unit, billing information entered into the order form by the user prior to sending the order form to the merchant server. However, Official Notice is taken that it is old and well known in the art to confirm a buyer's billing information prior to placing an order. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature into the method of Bezos. One of ordinary skill in the art would have been motivated to do so in order to ensure that the order was charged to the proper account.

Referring to claim 7: Bezos teaches all the limitations of claim 2 as noted above. Bezos does not teach the step of encrypting the order form prior to sending the order form to the merchant server. However, Official Notice is taken that it is old and well known in the art to encrypt an order prior to sending the order to a merchant. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention

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was made, to incorporate this feature into the method of Bezos. One of ordinary skill in the art would have been motivated to do so in order to use encryption to ensure the confidentiality and integrity of the order.

Referring to claim 21: Claim 21 is rejected under the same rationale as set forth above in claim 7.

Referring to claim 24: Claim 24 is rejected under the same rationale as set forth above in claim 6.

Claims 3-5, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bezos (US Patent 6,029,141) in view of Hamel (US 2002/0007393 A1).

Referring to claims 3-5: Bezos teaches all the limitations of claim 2 as noted above. Bezos does not teach the step of receiving, at the data processing unit, a banner applet to implement at least one of said presenting one or more advertised products, said receiving a purchase request, said providing an order form, and said processing an order form. Bezos also does not teach receiving, at the banner applet, a request for descriptive information related to the advertised product prior to said receiving a purchase request; and providing, by the banner applet, the descriptive information, wherein the descriptive information is presented on the display unit and includes an option to send the purchase request in response to input from the user. Finally Bezos does not teach providing, by the banner applet, an authorization request to be presented on the display unit in response to the purchase request; and implementing said providing an order form step in response to the banner applet

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receiving affirmation of the authorization request. However, Hamel teaches a method for browser-executed software wherein advertised products are presented in a web page using a banner applet (paragraphs [0075] and [0076]; Figure 1, items "132" and "135"). Furthermore, Hamel discloses that when a user selects an applet within a web page scripting programs cause the applet to be download to the client system which then performs various functions on the client computer (paragraph [0076]). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate a banner applet for performing various functions into the method of Bezos. One of ordinary skill in the art would have been motivated to do so in order to perform processing on the user's terminal as taught by Hamel (paragraph [0076]).

Referring to claims 10 and 11: Bezos teaches all the limitations of claim 1 as noted above. Bezos does not teach presenting the web pages in a first and second window, or displaying, by the data processing unit, the advertised product in a banner located within the first window, the banner containing a link that is capable of being activated to send the purchase request. However, Hamel teaches a method for browser-executed software wherein advertised products are presented in a web page using a banner applet (paragraphs [0075] and [0076]; Figure 1, items "132" and "135"). Hamel also teaches that when a user selects Ad 123 within a web page (i.e. first window), another webpage is opened (i.e. a second window) (paragraph [0078]). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate a first and second window into the method of Bezos. One of ordinary skill in the art would have been motivated to do so in order to allow a

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user to perform a "click-through" as taught by Hamel. The cited prior art does not teach that the second window displays an order form. However, the Examiner notes that this limitation is not functionally involved in the steps of the recited method. Therefore this limitation is deemed to be nonfunctional descriptive material. The steps of receiving, providing, and presenting would be performed the same regardless of what content was displayed in the second window. The differences between the content of the Applicants' second window and the prior art are merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to place any information in the second window of the cited prior art because such information does not functionally relate to the steps claimed method and because the subjective interpretation of information does not patentably distinguish the claimed invention.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bezos (US Patent 6,029,141).

Referring to claims 8 and 9: Bezos teaches all the limitations of claim 2 as noted above. Bezos does not explicitly disclose providing the merchant server as the hosting server, or operating the merchant server and the hosting server by an affiliate of a merchant that promotes the advertised product. However, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to have any

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arrangement in the setup of the merchant and hosting websites. Applicant has not disclosed that this particular arrangement of websites provides an advantage, is used for a particular purpose or solves a stated problem. Furthermore, one of ordinary skill in the art would have expected Applicants' invention to perform equally well with the arrangement taught by Bezos because Bezos uses a merchant website, a hosting website, and an affiliate of merchant that promotes the advertised product (Figure 1, items "100" and "106"; Abstract). Therefore, it would have been obvious to one of ordinary skill in this art to modify Bezos to obtain the invention as specified in the claims.

Response to Arguments

Applicants' arguments with respect to the rejection of claims 1-12 and 20-25 under 35 USC 103(a) have been fully considered but they are not persuasive. The Applicants have argued Bezos does not teach that the data processing unit "remains connected" to the hosting server during the interactive session (see Remarks pages 9-11; claim 1, lines 13 and 14) because Bezos teaches that the user uses the navigational controls to return to the associate's Web site. The Examiner respectfully disagrees. Bezos teaches that the associate web site is created using an HTML frame format that has three frames: a top frame for navigational controls, a bottom frame for the merchant's Web site, and an associate's Web page frame. Bezos teaches that the navigational controls in top frame are used to control the bottom frame for the merchant's Web site. This allows the user to visit the merchant's Web site and return

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using the navigational controls in the top frame. However, the third frame (i.e. the associate's Web page frame) remains unchanged and unaffected by the navigational controls. Bezos explicitly states that is arrangement of three frames "...allows the customer to maintain an associate's Web page frame while viewing and processing product purchases at the merchant's Web site 106." Thus, throughout the interactive session, the data processing unit remains connected to the hosting server via the third frame. For this reason, the Examiner maintains the art rejection.

The Examiner notes that the Applicants did not respond to the Examiner's Official Notice rejection of claims 6, 7, 21, and 24 in the previous Office Action. In order to adequately traverse a rejection based on common knowledge (i.e. Official Notice), an Applicant must specifically point out the supposed errors in the Examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. A general allegation that the claims define a patentable invention is inadequate. In the present case, the Applicants did not respond to the Examiner's rejection using Official Notice. Furthermore, the Applicants failed to argue why the noticed fact is not considered to be common knowledge or well-known in the art. Instead, the Applicants have provided a general allegation of patentability of claims 6, 7, 21, and 24. For this reason, Applicants' response is considered to be an inadequate traversal of the Official Notice used by the Examiner in the rejection of claims 6, 7, 21, and 24 under 35 U.S.C. §103(a).

Since the Applicants have failed to seasonably challenge the Examiner's Official Notice presented in the previous Office Actions, the Examiner now interprets all Official

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Notices as admitted prior art. *Applicant must seasonably challenge well known statements and statements based on personal knowledge when they are made. In re Selmi, 156 F.2d 96, 70 USPQ 197 (CCPA 1946). If Applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d71, 60 USPQ 239 (CCPA 1943). Also see MPEP 2144.03.*

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (571)-272-6758. The examiner can normally be reached on M-F 8:00am-5:00pm.

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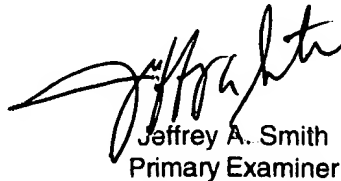
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571)-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Naeem Haq, Patent Examiner
Art Unit 3625

July 22, 2006



Jeffrey A. Smith
Primary Examiner